



# Office Action Summary

Application No.

09/293,266

Applicant(s)

BENNETT III ET AL.

Examiner

William J Deane

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

II. Claims 1 - 4, 8 - 11 and 14 - 17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,049,594 (Furman et al.).

With respect to claims 1, 3, 8, 10, 14, 16 Furman et al teach a method and system comprising receiving a dialed service code from a calling party (Col. 3, lines 48 - 56), retrieving a list of parties previously called by the calling party (Col. 5, lines 22 - 34), generating and communicating to the calling party an audio message based on the list (Col. 9, lines 20 - 25 and Col. 13 lines 61 - 64), receiving a dialed input from the calling party indicating a selected party from the list and initiating a call between the calling party and the called party ( Col. 7, lines 37 - 42).

With respect to claim 2, 9 and 15, note Col. 9, lines 32 - 33

With respect to claim 4, 11 and 17, note Col. 6, lines 41 - 45.

***Claim Rejections - 35 USC § 103***

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 5 - 7, 12 - 13 and 18 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furman et al in view of U.S. Patent No. 6,076,121 (Levine)

Furman et al teach the claimed device as discussed supra except for the use of vertical service codes and also with respect to claim 7 a PIN. Note that Levine teaches vertical service codes, which are less than seven digits (Col. 12, lines 1 - 19). It would have been obvious to one of ordinary skill in the art to have provided the use of vertical codes as taught by Levine in the device and method of Furman et al. as such would only entail the substitution of one known code for another.

With respect to claim 7 and the use of a PIN by a customer, note Col. 5, lines 13 - 21 of Furman et al. It would have been obvious to one of ordinary skill in the art to use an ID to designate customers in order to ensure privacy. In addition, with respect to claim 7, the limitation of generating a second audio message comprising a second plurality of names would have been obvious to one of ordinary skill in the art as such

would only entail duplicating a first audio message containing a plurality of names which is taught by Furman et al.

### ***Response to Arguments***

Applicant's arguments filed April 2, 2001, have been fully considered but are not deemed persuasive to any error in the above rejection.

At the last paragraph on page 2 and the first full paragraph on page 3, applicants argue that "Furman et al. do not disclose receiving a dialed input from the calling party, where the dialed input indicates a selected party from an audio list of previously called parties, initiating a call between the calling party and the selected party based on the dialed input". Applicants are simply wrong as Furman et al. do teach these limitations as shown above in the rejection of claims 1, 3, 8 10, 14 and 16.

Specifically, the limitations argued by applicants are clearly described in Col. 13, lines 61 – 64. Note that names from the list are spoken back to the caller and that the caller identifies the desired name with DTMF tones. That is, to select the name one wants one presses one or more buttons on his phone to verify the selection.

Applicants may argue that only some or a partial list of the names are spoken back to the caller and only under certain circumstances. However, it is noted that the spoken names in Furman et al. are based on the list of most frequently called numbers. Applicants may argue that the present invention requires all the names on the list must be spoken back to the caller. First, no such language is present in the claims. Second,

even if such claim language did exist, to go from a partial list to a full list would carry no patentable weight as to do so would be obvious to one of ordinary skill in the art.

Applicants go on to argue at page 3, 3<sup>rd</sup> paragraph, that the prior art does not disclose the use of a PIN and vertical service codes. However, as discussed above, Furman et al. teach the use of PINs (, note Col. 5, lines 13 - 21 of Furman et al.) and Levine teaches that vertical service codes are old in the art (Col. 12, lines 1 – 19 of Levine). To use both a PIN and vertical service codes in combination would have been obvious to one of ordinary skill in the art in order to provide layers of security.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9314.



WJD

11 June 01



**AHMAD MATAR**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**